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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-----------------------|---------------------|------------------|
| 10/016,905 | 12/14/2001 | Michael Von der Geest | 3107-237 | 9583 |

7590 07/28/2003

Lewis F. Gould, Jr.
Duane Morris LLP
One Liberty Place
Philadelphia, PA 19103-7396

EXAMINER

HARRIS, CHANDA L

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 07/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,905

Applicant(s)

VON DER GEEST ET AL.

Examiner

Chanda L. Harris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2001 and 22 July 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38, 45, 48-55, 59, 62 and 65-75 is/are rejected.
- 7) ☐ Claim(s) 39-44, 46, 47, 56-58, 60, 61, 63 and 64 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. For example, see page 13, paragraph [0026] (i.e. <http://www.ncsl.org.uk/index.cfm?pageid=211>). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

2. The use of the trademarks PALM, NETSCAPE NAVIGATOR, and MICROSOFT INTERNET EXPLORER has been noted in this application. For example, see page 4. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

3. The disclosure is objected to because of the following informalities: "PDDA" should be "PDA."

Appropriate correction is required.

Claim Objections

Claim 70 is objected to because of the following informalities: Line 7: "model date" should be "model data". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 59 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 59 recites the limitation "the medium" in Line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-35 and 70-75 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, Claims 1-35 and 70-75 only recite an abstract idea. The recited steps of merely receiving evaluation data for said environment ...; providing model data to an individual that is responsible for said environment ...; receiving from said individual responsible for said environment a selection of at least one of said one or more dimensions of said environment; and providing said individual responsible for said environment an action plan ..., does not apply, involve, use or advance the technological arts since all of the recited limitations can be performed in the mind of the user or by use of pencil and paper. These limitations only constitute an idea of how to how to assist in the development of an environment by performing evaluations and providing a plan for improvement of the environment.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention associates evaluation data or model data with at least one characteristic of an individual responsible for the environment (i.e. repeatable) used in providing the individual responsible for the environment an action plan (i.e. useful and tangible) .

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-35 and 70-75 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-3, 8-10, 15-17, 22-29, 31-38, 45, 48-55, 62, 65-74 are rejected under 35 U.S.C. 102(a) as being anticipated by Denison.

1. [Claims 1, 36, 53, 70]: Regarding Claims 1, 36, 53, and 70, Denison discloses receiving evaluation data for said environment (i.e. survey) from at least one individual (i.e. co-workers) participating in said environment, said evaluation data representing impressions of said individual regarding said environment (i.e. perception of co-workers); providing model data (i.e. Summary Report) to an individual that is responsible at least in part for said environment (i.e. manager), said model data representing one or more dimensions of said environment (e.g. leadership skills and practices), said model data developed at least in part from said evaluation data, each of said one or more dimensions being associated with at least one characteristic (i.e.

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specific aspect) of said individual responsible for said environment; receiving (e.g. via Summary Report) from said individual responsible for said environment a selection of at least one of said one or more dimensions (i.e. specific aspects) of said environment; and providing said individual responsible for said environment an action plan for improving at least one characteristic associated with said selected dimension (i.e. Action Planning Guide). See pp.2 and 4.

Denison's invention would have to be on a computer-readable medium encoded with a computer program (e.g. a hard disk), enabling it to be accessible on-line via the internet or an intranet. See p.4. Therefore, a computer-readable medium would have been an inherent feature of Denison's invention.

A data signal embodied in a carrier wave encoded with computer program code would have been an inherent feature of Denison's invention as a result of the invention being online. See p.4.

2. [Claims 2, 37, 54, 71]: Regarding Claims 2,37, 54, and 71, Denison discloses the step of receiving evaluation data for said environment from said individual that is responsible at least in part for said environment, said evaluation data representing an impression of said individual regarding said environment (i.e. manager's self perception/Self Assessment survey). See pp.2 and 4.

3. [Claims 3, 17, 38, 45, 55, 62]: Regarding Claims 3,17, 38, 45, 55, and 62, Denison discloses wherein said environment is a classroom teaching environment or a school environment (i.e. organization), said at least one individual participating in said environment includes a first plurality of students or a first plurality of employees (i.e. co-

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workers) within said classroom teaching environment or school environment (i.e. organization), and said individual responsible for said environment is a classroom teacher or a head teacher (i.e. manager). See p.2.

4. [Claim 15]: Regarding Claim 15, Denison discloses receiving from at least one individual (e.g. manager) participating in said environment reevaluation data (e.g. via post-testing) for said selected environment, said reevaluation data representing impressions of said at least one individual regarding said environment (e.g. self-perception) at a time after said evaluation data is received (implied by post-testing), providing second model data to said individual responsible for said environment (i.e. manager), said second model data representing one or more dimensions of said environment (e.g. leadership skills and practices), said second model data developed at least in part from said reevaluation data. See pp.2-3.

5. [Claim 16]: Regarding Claim 16, comparing said model data (i.e. pre-testing) and second model data (i.e. post-testing) would have been an inherent feature of Denison's invention and is best understood by Examiner as a necessary process by which leadership development progress is tracked. See p.3 of Denison.

6. [Claims 8, 22]: Regarding Claims 8 and 22, Denison discloses receiving from a second plurality of students or employees (i.e. co-workers) reevaluation data (e.g. via post-testing) for said selected classroom teaching or school environment, said reevaluation data representing impressions of said second plurality of students or employees regarding said environment (i.e. perception) at a time after said evaluation data is received from said first plurality of students or employees (implied by post-

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testing), providing second model data to said classroom teacher, said second model data representing one or more dimensions of said classroom teaching or school environment (e.g. leadership skills and practices), said second model data developed at least in part from said reevaluation data, each of said one or more dimensions being associated with at least one characteristic known to effect a respective dimension (i.e. specific aspect). See pp.2-3.

7. [Claims 9,23]: Regarding Claims 9 and 23, comparing said model data (i.e. pre-testing) and second model data (i.e. post-testing) would have been an inherent feature of Denison's invention and is best understood by Examiner as a necessary process by which leadership development progress is tracked. See p.3 of Denison.

8. [Claims 10, 24]: Regarding Claims 10 and 24, the second plurality of co-workers in Denison (e.g. performing the post-testing) can be considered to include one or more students or employees (i.e. co-workers) from the first plurality of students or employees (e.g. performing the pre-testing). See pp.2-3.

9. [Claims 25, 31, 48, 65,73]: Regarding Claims 25,31, 48, 65, and 73, Denison discloses said evaluation data received from said plurality of teachers or at least one individual participating in said environment (e.g. co-workers) include first leadership style data (e.g. leadership skills), said first leadership style data identifying a perception by said plurality of teachers (i.e. co-workers) of the use of a plurality of different leadership styles by said head teacher (i.e. manager); said first leadership style data identifying a perception of the use of a plurality of different leadership styles by said individual that is responsible for said environment (i.e. manager); said evaluation data

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received from said head teacher of the use of said plurality of different leadership styles by said head teacher (i.e. self perception); said evaluation data received from said individual that is responsible at least in part for said environment (i.e. manager) include second leadership style data (i.e. self-perception) identifying a perception of said individual that is responsible for said environment of the use of said plurality of different leadership styles by said individual that is responsible for said environment. See p.2.

10. [Claims 26,32,49, 66, 74]: Regarding Claims 26,32, 49, 66, and 74, Denison discloses the step of providing leadership model data (i.e. Summary Report) representing usage of leadership styles by said head teacher, said leadership model data being developed at least in part from said first leadership style data and said second leadership style data. See p.2.

11. [Claims 27,33, 50, 67]: Regarding Claims 27, 33, 50, and 67, Denison discloses the step of receiving an identification of one or more leadership styles from said plurality of different leadership styles (e.g. by way of Summary Report), said one or more leadership styles being associated at least one of said one or more dimensions (i.e. specific aspects). See p.2.

12. [Claims 28-29,34-35,51-52, 68-69]: Regarding Claims 28-29,34-35, 51-52, and 68-69, Denison discloses providing said head teacher (i.e. manager) or individual responsible for said environment an action plan (i.e. Action-Planning Guide) for improving said selected one or more leadership styles and providing said head teacher or individual responsible for said environment and an action plan for improving at least

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one characteristic (i.e. specific aspect) of said head teacher associated with one or more leadership styles. See p.2.

13. [Claim 72]: Regarding Claim 72, Denison discloses wherein said model data (i.e. Summary Report) is developed at least in part from said evaluation data received from said individual that is responsible at least in part for said environment (i.e. manager). See p.2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denison in view of Wadahama (US 6,024,577).

1. [Claims 4,18]: Regarding Claims 4 and 18, Denison does not disclose expressly the step of receiving from said classroom teacher or said head teacher (i.e. instructor) a designation of said first plurality of students or employees participating in said classroom teaching environment (e.g. by using voice channels or by sending e-mail messages), said first plurality of students or employees being designated to provide said evaluation data. However, Wadahama teaches such in Col.5: 42-48. Therefore, at

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the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the aforementioned limitations into the method and system of Denison, in light of the teaching of Wadahama, in order to inform the classroom teacher or the head teacher of the students' understanding levels during the class.

Allowable Subject Matter

1. Claims 39-44, 46-47, 56-58, 60-61, and 63-64 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
2. Claim 59 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ibarra (US 6,119,097)
-performance appraisal summary
- Guinta et al. (US 2002/0137015)
-accessing an organizational process or system
- Thean et al. (US 6,397,036)

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-collaborative learning

- Meredith (US 2002/0058233)

-action plans

- Gupta

-Technical Wizards, Lousy Managers: Avoiding Disasters in Promoting and Hiring IT

Management

- Fleishman (US 2003/0008270)

-leadership training program

- Lingwood et al. (US 2003/0033233)

-recommendations for improvement

- Roschelle et al. (US 2002/0115049)

-feedback regarding material

- Mishkin et al. (US 2002/0068263)

-computer-based peer review process

- Fast et al. (US 2003/0091970)

-constructive feedback

- Chao et al. (US 6,325,632)

-matching students with instructors

- Stuppy et al. (US 2003/0049595)

-matching students with teachers

- Morrel-Samuels (US 5,795,155)

-leadership assessment tool

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- Sketch (US 2002/0077884)
 - assessing an employee's level of competency
- Hudy (US 6,594,668)
 - providing employees with feedback of their performance
- D'Alessandro (US 5,556,974)
 - evaluating current business performance
- Morrel-Samuels (US 5,743,742)
 - measuring leadership effectiveness
- Moskowitz et al. (US 2002/0177115)
 - presentation evaluations

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanda L. Harris whose telephone number is 703-308-8358. The examiner can normally be reached on M-F 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

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Chanda L. Harris

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Examiner

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July 23, 2003